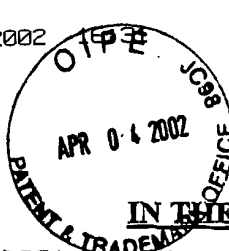


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EITAN PEARL LATZER+COHEN-ZEDEK

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JC05 Rec'd PCT

PATENT
R-1476
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#7

APPLICANT(S): Michal Linial, Nathan Linial, Nafali Tishby and Golan Yona
SERIAL NO.: 09/601,278 PCT Legal Examiner: Bryan Tung
FILED: July 31, 2000 Group Art Unit:
FOR: AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES

COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231
BOX: PCT (EO/US)
ATTN: PCT Legal Office

RECEIVED

12 APR 2002

Legal Counl
International Division

A SECOND RENEWED PETITION UNDER 37 C.F.R 1.47 (a)

Dear Sir:

This Renewed Second Petition Under 3 C.F.R 1.47(a) is filed in response to the Decision on Renewed Petition Under 37 C.F.R 1.47(a) dated October 4, 2001 in connection with the above-identified Application. This Second Renewed Petition requests that the above identified application be accepted for United States national stage processing without the signature of one of the four joint inventors. A response to October 4, 2001 Decision must be filed December 4, 2001. Applicants are concurrently filing a Petition for Four-Months Extension of Time and the required fee. Therefore, response is now due April 4, 2002. Accordingly, this Second Renewed Petition is being timely filed.

In the Decision, the PCT Legal Examiner asserted that the Renewed Petition under 37 CFR 1.47(a) satisfied the requirements under 37 CFR 1.47(a) requesting i) an oath and declaration by each Applicant on his or her own behalf of the nonsigning joint inventors, iii) the fee set forth in 1.17; and iv) the last known address of the non signing inventors. However, the PCT Legal Examiner asserted that Applicants: i) have allegedly failed to present Golan Yona a copy of the complete application paper; and ii) have allegedly failed to provide factual proof that the missing joint inventor refuse to join in the application or cannot be reached after diligent effort.

In response, Applicants attached hereto a Second Supplemental Declaration in which Renee Ben Israel, Intellectual Property Manager of Yissum Research Development Company of the Hebrew University of Jerusalem states that she made numerous bona fide attempts to obtain

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Applicant: Linial et al.

File No.: P-1476

Serial No.: 09/601,278

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the signature of Golan Yona on the Declaration and Power of Attorney through extensive correspondence.

Specifically, on December 13, 2001, a letter including a copy of the above identified application was sent to Mr. Meir Dahan, patent legal counsel of Golan Yona (a copy of the letter is attached hereto as Exhibit 9). In the letter, Ms. Renee Ben Israel, requested Meir Dahan to send the copy of the above identified Application to Golan Yona. On December 16, 2001, a letter including a copy of the above identified application was sent to Golan Yona, together with a copy of the Oath & Declaration, and the Assignment (a copy of the letter is attached hereto as Exhibit 10). On January 9, 2002, Mr. Meir Dahan sent a letter to the legal council of Yisum, confirming that Golan Yona has received the documents from Yisum (a copy of the letter is attached hereto as Exhibit 11), however, despite the bona fida attempts to send the documents to Golan Yona and to his patent legal counsel, Golan Yona refused to provide signed copy of the Declaration and the Power of Attorney.

Thus, this Second Renewed Petition is in compliance with 37 CFR 1.47(a) and M.P.E.P Section 409.03. Therefore, Applicants hereby Petition under 37 C.F.R. 1.47(a) that the subject Application may be made by the other named joint applicants on behalf of themselves and the non-signing named joint applicant. Accordingly, Applicants request that the Patent Office grant this Petition and join the non-signing named joint inventor to the subject Application on filing the attached Oath or Declaration in compliance with 37 C.F.R. 1.63.

If any additional fee is due, the undersigned hereby authorizes the Patent and Trademark Office to charge such fee to Deposit Account 05-0649.

Respectfully Submitted,

Mark S. Cohen
Registration No. 42,425
Attorney for Applicants

April 4, 2002
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2011 Crystal Drive
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SUPPLEMENTAL DECLARATION

I, Renee Ben-Israel, residing at 13/5 Hahayil Street., Jerusalem, Israel 97891, do hereby declare as follows:

1. I am employed in the Intellectual Property Department of the Yisum Research Development Company of The Hebrew University of Jerusalem having a mailing address of P.O.B. 4279, Jerusalem 91042 ("Yisum"). My position is Intellectual Property Manager.
2. I am responsible for the patent administration of all patents and patent applications filed in any jurisdictions through Yisum for The Hebrew University of Jerusalem. My duties include coordinating patent filing and prosecution such as acting as an intermediary between employees of The Hebrew University of Jerusalem who are named inventors on a patent application and the laws firms prosecuting the specific patent application in order to obtain patent related documents necessary for filing or conducting prosecution in the United States Patent and Trademark Office and in other jurisdictions.
3. The subject application U.S 09/601,278 entered the United States National Stage (EO) under 35 U.S.C. 371 on July 31, 2000 and corresponds to PCT International Application No. PCT/IL99/00057, International Filing Date January 29, 1999 entitled "An Automatic Method Of Classifying Molecules", in the name of Yisum Research Development Company of The Hebrew University of Jerusalem as Applicant, and Natan Linial, Michal Linial, Naftali Tishby and Golan Yona as joint inventors for US only (the "subject Application"). The PCT Application claims the priority of U.S Provisional Application 60/072,977, filed on January 29, 1998.
4. On February 22, 2001, I submitted a Declaration in regard to the request that the subject application be accepted for processing without the signature of Golan Yona who is one of the named inventors, on the oath and declaration.
5. In response, the PCT Legal Office of the United States Patent and Trademark Office, issued a Decision and Petition, dated June 12, 2001, a copy of which is

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attached hereto as Exhibit 1, that according to the requirements under 37 CFR 1.47, applicants have submitted a Declaration by each Applicant on his or her own behalf and on behalf of the nonsigning inventors, Applicants have provided the requisite petition fee and the Petition states the last known address of the nonsigning inventor. However, the PCT Legal Officer concluded in the Decision that applicants have failed to i) demonstrate that a bona fide attempt was made to present a copy of the complete application paper to Golan Yona and ii) provide adequate proof on Yona's purported refusal to sign the application papers.

6. As I stated in the Declaration, I forwarded to the named inventors Natan Linial, Michal Linial, and Naftali Tishby, who were in Israel at the time, a copy of a Declaration and Power of Attorney requesting that they sign the Declaration and Power of Attorney in connection with the subject Application. On September 17, 2000, Natan Linial, Michal Linial, and Naftali Tishby signed and dated the Declaration and Power of Attorney. A copy of the Declaration signed by Natan Linial, Michal Linial, and Naftali Tishby is attached hereto as Exhibit 2.
7. Since I understood that Golan Yona was going to be in Israel in September 2000, I did not forward a copy of the subject Application and a copy of Declaration and Power of Attorney for his signature but rather waited until he arrived in Israel. When he did not arrive in Israel in September 2000, on October 3, 2000, I forwarded to Golan Yona by facsimile a copy of the Declaration and Power of Attorney requesting that he sign the Declaration and Power of Attorney in connection with the subject Application. A copy of the e-mail which was forwarded to Golan Yona requesting his signature on the Declaration and Power of Attorney in connection with the subject Application is attached hereto as Exhibit 3.
8. Since Golan Yona reviewed the subject Application as evidence of Yona e-mail dated November 2, 2000, a copy of which is attached hereto as Exhibit 4, I did not forward him a copy of the Subject Application. In the e-mail dated November 2, 2000 Golan Yona stated that "part of the text [of the Subject Application] is incorrect and I would have excluded it, had I seen the application before".

9. Further, attached here as Exhibit 6 is a letter dated December 27, 2000 from Meir Dahan who is patent legal council of Golan Yona further stating that Golan Yona has obtained a copy of the PCT and also has remarks on the Claims. In the letter (page 2) Meir Dahan agreed that Golan Yona would sign the documents in connection with the Subject Application but subject to the condition that these documents will rightly and truly reflect the factual inventional and legal reality". In other words, he would not sign until Yisum agreed with his ownership interest which it does not. Further as admitted by Meir Dahan on behalf of his client, Golan Yona obtained a copy of the PCT Application which the Subject Application corresponds to.
10. In addition, in the Decision, the PCT Legal Officer asserted that "applicants have not provided adequate proof on Yona's purported refusal to sign the application papers". The Examiner asserted that "Ben-Israel's affidavit states that Ben Israel made numerous attempts to obtain Yona's signature on the declaration (see paragraph 10 of Ben Israel's affidavit), yet failed to provide any details regarding the alleged attempts".
11. In response, as I stated in the Declaration between November 2000 and December 2000, I made numerous attempts to obtain the signature of Golan Yona on the Declaration and Power of Attorney through extensive correspondence through the e-mail in, a conference call November 6, 2000 and faxes in connection with the subject Application and to settle the issues Golan Yona raised. The papers were sent to Yona by mail on November 14, 2000 and to his Patent legal council Meir Dahan, on February 17, 2001. It should be noted that Yona himself referred in the e-mail dated at about November 2, 2001 to "repeated claims by you and by Nati". These attempts were unsuccessful as Golan Yona never returned the Declaration and Power of Attorney signed but rather used the time to negotiate his ownership interest in the Patent Application.
12. Between October 2000 and February 2001, communications were also conducted through respective legal council of Yisum and Golan Yona regarding issues as to ownership of the rights in the PCT Application. Patent legal council for Golan Yona have been notified in a fax dated February 19,

2001, that a response to the Notification was due (Exhibit 7) and also have not responded by providing a signed Declaration and Power of Attorney in view of the deadline (February 22, 2001). Moreover, I sent to the Patent legal council for Golan Yona a reminder on February 21, 2001 (attached hereto as Exhibit 8), and it was left unanswered.

13. Golan Yona was afforded in every opportunity to sign the Declaration, since of November 2000, from when he admitted he reviewed a copy of the PCT Application through February 21, 2001.
14. On December 13, 2001, I sent a letter to Meir Dahan, the Patent legal council for Golan Yona including a copy of the above identified application, via Registered Mail and requested Meir Dahan to forward the copy of the above identified application to Golan Yona. A copy of the letter is attached hereto as Exhibit 9.
15. On December 16, 2001, I sent a letter to Golan Yona including a copy of the above identified application, together with the Declaration, the Power of Attorney and the Assignment, via Registered Mail. A copy of the letter is attached hereto as Exhibit 10.
16. On January 9, 2002, Meir Dahan, the Patent legal council for Golan Yona sent a letter to the legal council of Yisum which confirmed that Golan Yona received a copy of the above identified application and of the Oath & Declaration. Again, Golan Yona refused to sign the Oath & Declaration. A copy of the letter which was written in Hebrew, together with a certified translation to English are attached hereto as Exhibit 11.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Renee Ben-Israel

April 4, 2002

Renee Ben-Israel
Vice-President Intellectual Property
Intellectual Property Department
Yissum Research Development Company
of the Hebrew University of Jerusalem
P.O.B. 4279, Jerusalem 91042

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